

Office Action Summary**Application No.**

10/578,792

Applicant(s)

BERG ET AL.

Examiner

LUKE KARPINSKI

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/05/2011 has been entered.

Claims

Claims 2-5 are canceled.

Claims 1 and 6-11 are pending.

Claims 8-11 are withdrawn.

Claims 1, 6, and 7 are under consideration in this action.

Rejections

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0979645 to Gonzenbach in view of US 2004/0047817 to Bonda et al.

Applicant Claims

Applicant claims a composition comprising a) a polysiloxane based UV filter, specifically polysilicone-15 (Parasol SLX) b) an additional UV agent selected from the list of claim 1, c) a carrier, and optionally d) an additional UV filter.

Applicant further claims specific additional UV filters, and ratios for said UV filters.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Gonzenbach et al. teach light screening compositions comprising the same polysiloxane-based UV filters as claimed in claim 1 (page 1-5), which read on polysilicone-15 (Parasol SLX), the same additional UV filters as claimed in claims 1 and 6, (phenylbenz-imidazole sulfonic acid and methylene bis-benzotriazo tetramethylbutylphenol (Tinosorb M)) (page 6), a carrier (aqueous phase and fatty phase) (abstract), as pertaining to claim 1, and percentages of said polysiloxane-bases UV filter and said additional UV filters as pertaining to the ratio of claim 7 ([19] and claim 8).

Ascertainment of the Difference between Scope the Prior Art and the Claims (MPEP §2141.012)

Gonzenbach et al. do not teach percentages for Tinosorb M or that the percentage present for said polysiloxane based UV agent is less than the sum amount of UV filters b) and d) as pertaining to claim 7. This deficiency in Gonzenbach et al. is cured by Bonda. Bonda teaches that Tinosorb M is typically present up to 10% [36].

Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)

Regarding claim 7, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to produce the formulations of Gonzenbach et al. with, 10% phenylbenzimidazol 5% of said polysiloxane based UV agent , and 10% Tinosorb M as taught by Bonda et al. in order to produce the invention of instant claim 7.

One of ordinary skill in the art would have been motivated to do this because both references teach to UV agents such as Tinosorb M and Bonda teaches a preferred percentage limit for Tinosorb M. Therefore it would have been obvious to utilize up to and including the maximum preferred amount of Tinosorb M of Bonda, in the formulations of Gonzenbach et al. in order to use said components in known and preferred amounts. Since Bonda teaches 10% Tinosorb M, Gonzenbach et al. teach 10% phenylbenzimidazole as well as said polysiloxane UV agent preferably present at 20% and more preferably present at 5%, it would have been obvious to produce a formulation in which the combined amounts of Tinosorb M and phenylbenzimidazole are greater than the amount of said polysiloxane UV agent. It is noted by the examiner that

optimization of UV agents is common in the art and would have been expected by one of ordinary skill. Applicants claims to ratios of 3 such UV components which are not explicitly disclosed, but are taught by the combination of references, is not novel or patentable absent a showing of unexpected results when said specific ratio is used.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Response to Arguments

Applicant's arguments filed 8/05/2011 have been fully considered but they are not persuasive.

Applicant argues that Gozenbach et al. teach a large laundry list of UV compounds.

This argument is not found persuasive because Gozenbach et al. only teach 33 specific UV compounds from page 6, line 29 through page 7, line 2.

Applicant also argues to the percentage of homosalate and the ratio of homosalate to polysiloxane component.

These arguments are moot because applicant has amended homosalate out of the instant claims and homosalate is no longer used in the rejection of said claims.

Applicant also states that "greater than expected results is an evidentiary factor pertinent to the legal conclusion of obviousness".

This statement does not pertain to the instant application as there is currently no showing of unexpected results.

Conclusion

Claims 1, 6, and 7 are rejected.

No claims are allowed.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUKE KARPINSKI whose telephone number is (571)270-3501. The examiner can normally be reached on monday-friday 9-5 est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEK

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616